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## Foxworthy v. Custom Tees, Inc.,

879 F. SUPP. 1200 (N.D. GA. 1995).

### INTRODUCTION

The plaintiff, Jeff Foxworthy ("Foxworthy"), a comedian, commenced an infringement action against the defendant, Custom Tees, Inc. ("Custom Tees"), claiming the defendant violated the copyright in his currently popular "You might be a redneck if . . ." jokes<sup>1</sup> by printing and marketing t-shirts with slogans similar to Foxworthy's redneck jokes. In its opinion, the United States District Court for the Northern District of Georgia granted Foxworthy's motion for a preliminary injunction holding in pertinent part<sup>2</sup> that: (1) the phrase "you might be a redneck" was entitled to trademark protection; (2) the comedian's jokes were entitled to copyright protection; (3) the comedian successfully established a likelihood of confusion necessary for preliminary injunctive relief; and (4) the balance of hardships favored the comedian.

### FACTS

Comedian Jeff Foxworthy is known throughout the country for his "you might be a redneck if . . ." jokes. His album, *You Might be a Redneck If . . .*, has sold more copies than any other comedy record in more than a decade. Foxworthy claims copyright ownership to hundreds of these one-liner jokes as well as a common-law trademark in the phrase "you might be a redneck if . . ."<sup>3</sup> In addition to his live performances and the comedy album, Foxworthy has marketed a calendar with one such joke for every day of the year, and he sells t-shirts with his redneck jokes on them at his concerts and elsewhere.

In December 1994, Foxworthy became aware that t-shirts bearing the "you might be a redneck if . . ." jokes were being sold in stores across the country. The only difference between Foxworthy's jokes and those on the t-shirts was the format. On these shirts the phrase ". . . you might be a redneck" followed the punch line rather than precede it as in Foxworthy's jokes. The source of these t-shirts was determined by Foxworthy and his associates to be the defen-

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1. Examples of the punch lines to these jokes, as given in the text of the opinion include: "you might be a redneck . . . you've ever financed a tattoo . . . [and] you might be a redneck if . . . your dad walks you to school because you're in the same grade." Foxworthy v. Custom Tees, Inc., 879 F. Supp. 1200, 1204 (N.D. Ga. 1995).

2. In order to concentrate on the aspects of this case most relevant to art and entertainment law, the court's consideration of venue, forum and personal jurisdiction is omitted from this case summary. These jurisdictional issues were adjudicated based on well-established principles of law unrelated to the copyright issues.

3. The court uses the term "trademark" throughout its analysis for convenience, though Foxworthy also claims a service mark in connection with his entertainment services.

dant, Custom Tees, Inc. Custom Tees admitted producing and marketing the t-shirts. Once notified that the jokes on the tee shirts violated Foxworthy's copyright and/or trademark, Custom Tees sought legal counsel. Subsequently, Custom Tees modified the copy on its shirts to read "... you ain't nothin' but a redneck" following the punch line. Prior to trial, Foxworthy sought a preliminary injunction to prevent further manufacturing and distribution of the shirts.

### LEGAL ANALYSIS

As this was a ruling on the plaintiff's motion for preliminary injunction, the court first set out the requirements for success on the motion. In doing so the court titles many of the sections and subsections of its opinion in a form which mimics the style of the redneck jokes about which the plaintiff has filed suit. For example, within its analysis, the court uses headings such as: "Plaintiff Might be Entitled to a Preliminary Injunction If . . . ," "Plaintiff Might be Likely to Succeed on the Merits If . . . " and "The Public's Interest Might be Served If . . . ." Along those lines, the court stated that in order to be entitled to a preliminary injunction, a plaintiff must show: (1) a substantial likelihood that he will succeed on the merits; (2) that he will suffer irreparable injury unless the injunction is issued; (3) that the threatened injury to the movant outweighs whatever damage the proposed injunction may cause the opposing party; and (4) that the injunction, if issued, would not be adverse to the public interest.<sup>4</sup> Having set out the criteria, the court duly examined each of the specified factors, though clearly the factor related to the likelihood of the movant's success merited the vast majority of the court's attention. Because Foxworthy's jokes are composed of a combination of copyright and common-law trademark components, the court divided its "likelihood for success" analysis into separate copyright and trademark sections.

The court began its trademark analysis by noting that unregistered, common-law trademarks are protected from infringement by unauthorized use where that use is likely to cause confusion among the consuming public as to the source of the goods or services at issue.<sup>5</sup> In order to prove a violation of the Lanham Act, the plaintiff must prove: (1) that he has trademark rights in the mark or name at issue; and (2) that the defendant adopted a mark or name that is the same, or confusingly similar, to the plaintiff's mark, such that there is a likelihood of confusion for consumers as to the proper origin of the goods in question.<sup>6</sup>

Under this two-part formula, the first inquiry for the court was whether Foxworthy in fact had a trademark to protect. The court answered this question in the affirmative based in part on its conclusion that the phrase "you might be a redneck" is commonly associated with the plaintiff. Such association of the phrase to the plaintiff is a result of Foxworthy's extensive marketing of a calen-

4. Zardui-Quintana v. Richard, 768 F.2d 1213, 1216 (11th Cir. 1985).

5. Lanham Trademark Act § 43(a), 15 U.S.C. § 1125(a) (1993).

6. Conagra, Inc. v. Singleton, 743 F.2d 1508, 1512 (11th Cir. 1984).

dar and book using the phrase in their titles and his consistent use of the phrase as the title for most of his concert tours, television specials and videocassettes. The court's conclusion was also based on its determination that although the phrase arguably served a functional role as the vehicle for delivery of Foxworthy's various punch lines, the functional aspect of the phrase did not defeat its ability to be protected since it also played a clear role in identifying and distinguishing Foxworthy's brand of redneck humor from other uses of the same subject matter.<sup>7</sup>

The second prong of the court's Lanham Act analysis was whether the defendant's t-shirts were likely to cause confusion among the consuming public with respect to the products' source and their connection to Foxworthy.<sup>8</sup> This factor was described by the court as the essence of traditional Lanham Act analysis. Since Custom Tees had modified its t-shirts to use the "When . . . you ain't nothin' but a redneck" wording upon notification of Foxworthy's suit, the question before the court therefore was whether this phrase was likely to confuse the public as to whether Foxworthy was the source of the shirts. The court resolved this issue by employing a list of seven specific factors articulated by the Eleventh Circuit in *Conagra, Inc. v. Singleton*.<sup>9</sup> The court addressed each of the factors in turn, concluding that each factor favored the plaintiff, some more strongly than others. None of the factors were determined to favor the defendant, and the court therefore concluded that the defendant's t-shirts would cause confusion among the consuming public.

Having shown a violation of the Lanham Act, the court then examined the copyright aspects of the case with respect to the plaintiff's prospects for success on the merits. This inquiry consisted of two main themes: (1) whether Foxworthy was the owner of a valid copyright; and (2) whether the copyrighted works were unlawfully copied by the defendant. The second determination would, according to the court, require a showing that the defendant had access to the copyrighted work and that the defendant's work is substantially similar to that of the plaintiff.<sup>10</sup>

The court found that Foxworthy did have a valid copyright in his jokes, and furthermore, that the fact that Foxworthy had received some portion of his ideas for the redneck jokes from other people was irrelevant since Foxworthy testified that it was he who put all of the ideas, regardless of their source, into the recog-

7. See *Dallas Cowboy Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 203 (2d Cir. 1979).

8. See *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368, 389 (5th Cir. 1977).

9. The factors to be considered were: (1) the strength of the plaintiff's mark; (2) the similarity between the plaintiff's mark and the allegedly infringing one; (3) the similarity between the products and services offered by the plaintiff and the defendant; (4) the similarity of the sales methods employed by each party; (5) the similarity of the advertising methods; (6) the intent of the defendant, i.e., whether the defendant was hoping to gain a competitive advantage by associating its product with the plaintiff's mark; and most persuasively, (7) whether there was actual confusion. *Conagra*, 743 F.2d at 1514.

10. *Howard v. Sterchi*, 974 F.2d 1272, 1275 (11th Cir. 1992).

nizable format at issue in this case. The court stressed the fundamental basis of copyright law — that it was Foxworthy’s particular expression, not the ideas or subject matter, which were deserving of protection.<sup>11</sup> Because Custom Tees had, according to the court, clearly copied the plaintiff’s jokes verbatim, there was no need for a detailed examination of substantial similarity.

Following the substantive analyses, the court concluded its opinion by addressing the three other determinative factors relevant to issuance of a preliminary injunction. As to the question of irreparable injury to the plaintiff were the injunction not issued, the court noted that once a *prima facie* showing of either trademark or copyright infringement is made by a plaintiff, irreparable harm is ordinarily presumed.<sup>12</sup> Regarding the factual inquiry into the balance of hardships required in preliminary injunction analysis, the court held that Foxworthy would suffer the greater burden.<sup>13</sup> The court answered affirmatively that the public interest would be served by issuing an injunction in the instant matter. The court held such interest in protecting valid trademarks was achieved by preventing confusion among consumers. Having found that all four factors in the preliminary injunction analysis favored the movant, Foxworthy, the motion was accordingly granted.

#### CONCLUSION

Foxworthy sued the manufacturer of t-shirts imprinted with “you might be a redneck if . . .” jokes for infringement of his copyright and trademark. On Foxworthy’s motion for preliminary injunction, the United States District Court for the Northern District of Georgia granted the plaintiff’s motion for summary judgment, holding that there was a likelihood of success on the merits. The court’s conclusion rested, in part, on the grounds that Foxworthy had established a protectable trademark in the phrase “you might be a redneck if . . .” and that the defendant’s t-shirts would cause confusion among the consuming public as to the source of the products or their association with the plaintiff. The court’s conclusion was also based on a finding that Foxworthy held a valid copyright in the redneck jokes and that Custom Tees had directly copied those jokes without permission from Foxworthy.

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11. *Feist Publications, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 348 (1991).

12. *Original Appalachian Artworks, Inc. v. Topps Chewing Gum, Inc.*, 642 F. Supp. 1031, 1040 (N.D. Ga. 1986).

13. At a minimum, Foxworthy would be forced to compete with an infringer until the matter could be adjudicated, whereas Custom Tees would only be prevented from selling infringing products were the injunction issued.